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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of: Michael D. Zoeckler)

Examiner: Harmon, C.R.

Serial No.: 09/818,023)

Art Unit: 3721

Filed: March 27, 2001)

Attorney Docket No.: 7137 CIP1
(R029 1057)For: PAPERBOARD CARTONS WITH
LAMINATED REINFORCING RIBBONS
AND TRANSITIONED SCORES AND
METHOD OF MAKING SAME)REPLY BRIEFMail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

SUMMARY

The July 10, 2003 Final Office Action maintained the rejection of claims 1-5, 7, 11, and 33-37 under 35 U.S.C. § 103(a) as being unpatentable over *Campbell* in view of *Seufert* '916, the rejection of claim 6 as being unpatentable over the combination of *Campbell* and *Seufert* '916 and further in view of *Seufert* '206, and the rejection of claims 8-10 and 12-15 as being unpatentable over *Campbell* and *Seufert* '916 and further in view of *Haddock*. Applicant continues to traverse these rejections and has appealed to the Board for relief.

ATLANTA 392550v1

I. The proposed combination of *Campbell* with *Seufert* '916 is improper

A. Graham v. Deere

The basic test for non-obvious subject matter is whether the claimed subject matter would have been obvious to a person having ordinary skill in the art to which the subject matter pertains in contemplation of the prior art. The United States Supreme Court in Graham v. John Deere & Co., 383 U.S. 1 (1966), set forth the factual inquiries to be considered:

- (1) determining the scope and content of the prior art;
- (2) ascertaining the differences between the prior art and the claims at issue; and
- (3) resolving the level of ordinary skill in the pertinent art.

In order to establish a *prima facie* case of obviousness, it is necessary for the Examiner to present evidence, preferably in the form of some teaching, suggestion, incentive, or inference in the applied prior art, or in the form of generally available knowledge that would have led one having ordinary skill in the art to combine the relevant teachings of the applied references in the proposed manner to arrive at the claimed invention. The proper inquiry thus is whether bringing the references together was obvious and not whether one of ordinary skill, having the invention before him, would find it obvious through hindsight to construct the invention. Accordingly, an Examiner cannot establish obviousness simply by locating references that might describe various aspects of the pending application's invention without also providing evidence of the motivating force that would lead one skilled in the art to do what the inventor has done. The Examiner here has failed to meet his burden under Graham since the applied references fail to support the proposed combination.

B. *Campbell* and *Seufert* teach away from each other and thus cannot be combined

In order to make a case of obviousness, "a prior art reference must be considered in its entirety, i.e. as a whole, including portions that would lead away from the claimed invention."

W.L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). It accordingly is not permissible simply to choose isolated teachings or disclosures in such references in order to try to make a claim of obviousness under § 103. See MPEP § 2142.02; In Re Antonine, 559 F.2d 618, 195 USPQ 6 (CPA 1977).

The Examiner's comments provided in the June 30, 2003 Interview Summary illustrate that the Examiner has chosen only an isolated section of *Seufert* '916 justify a combination with *Campbell*. The Examiner states: "Examiner uses Seufert's teachings of widening fold lines regardless of scoring procedure." This is precisely the type of piecemeal examination that is precluded under Graham in formulating an obviousness rejection. The Examiner has chosen a preferred, isolated passage from a reference without properly reading the reference as a whole. The Examiner thus has taken a salient portion of *Seufert* '916 and declared that the teaching is only being used for a desired purpose, with the remainder of the reference's teachings ignored.

A more complete review of *Seufert* '916 further illustrates this impropriety since the foil window layer of *Seufert* '916 is never scored, but rather is only placed on a cardboard blank that already has been scored. *Campbell* is the only reference of the two that discusses scoring of a reinforcing material. Thus, in order to establish a proper combination of *Campbell* with *Seufert* '916 to reach the claimed invention, the thinned down layer of *Seufert* '916 would have to be substituted for the reinforcing tape in the method of *Campbell*. However, since the reinforcing layer of *Campbell* is placed on the paperboard while the adhesive between the tape and cardboard is still wet and then scored, the lining of *Seufert* '916 likewise would have to be used in place of the lining of *Campbell* and then scored. Such scoring clearly would weaken the already thinned down lining of *Seufert*, which is not a reinforcing layer, and would render the lining unusable as a reinforcing layer--precisely contrary to the function intended in the reinforcing layer of

Campbell. Accordingly, since use of the lining of *Seufert* '916 in the method of *Campbell* would be contrary to the teachings of both *Campbell* and *Seufert* '916, the combination cannot be made and rejections based thereupon are improper and should be withdrawn.

Additionally, *Campbell* requires that the scoring be done only after the reinforcing tapes are applied to the carton blank while the bond between the tapes and the carton or container blank is still wet to allow the tapes to slip to prevent distortion and cracking of the adhesive during scoring. In contrast, *Seufert* '916 teaches the formation of thinned down areas in the plastic foil blank 3 to compensate for stresses in the foil material, which can be formed concurrently with the formation of the bend lines 13 in the plastic foil material. The thinned down areas in *Seufert* '916 are formed in the foil before the foil is applied to the cardboard blank for precise alignment with groove lines already scored in the cardboard blanks. Consequently, the foil is not scored subsequent to applying the foil to the cardboard of *Seufert* '916.

The scoring of *Campbell*, however, necessarily must be done after application of the tapes to the fiberboard material while the glue between the tape and fiberboard material is still wet to enable shifting or movement of the two pieces. This required allowance for shifting or movement would appear to affect or diminish the precise alignment of the bend lines of the foil material with the fold lines of the cardboard as necessarily required by *Seufert* '916. Also, as shown in Fig. 12 of *Seufert* '916, when the blank of *Seufert* '916 is folded, the foil material 3 bends inwardly and away from the cardboard to compensate for stresses by bending, rather than engaging and reinforcing the blank as required by *Campbell*. Thus, these references teach away from each other and lack any suggestion to combine their teachings.

C. Even if they could be combined, no motivation exists to combine *Campbell* with *Seufert* '916

To establish a *prima facie* case of obviousness for combining or modifying the teachings of prior art to produce the claimed invention, there must be a showing or some teaching, suggestion or motivation to make such combination found either in the references themselves or in the knowledge generally available to one of skill in the art. However, the Examiner's Answer presents no such suggestion to combine the folding display box of *Seufert* '916 with the method of reinforcing fiberboard taught by *Campbell* has been offered or shown in the rejection of the currently pending claims. Instead, the Examiner, in the Examiner's Answer, continues to perform a piecemeal rejection of the claims and continues to argue that the combination would "compensate stresses in the laminate materials when folded into the final product and thereby maintaining the bond between the laminates," without providing the necessary support or motivation to make the cited combination (see page 4). The Examiner continues:

In this case, Campbell et al. recognize the difficulties of maintaining bonds between reinforcing laminates and their paperboard counterparts due to stresses applied during folding along score lines upon erecting the finished receptacles; see page 1, lines 67-80. The teachings of Seufert are directly related to this problem and are used to overcome any interference between laminates in laminated web materials. Seufert indicates application of his invention to "all types of folding boxes and other foldable packaging units"; column 6, lines 38-39.

Neither reference provides this reasoning nor is the Applicant able to find how these passages provide the required suggestion or teaching to justify the combination of *Campbell* with *Seufert* '916. The Examiner has thus failed to meet his burden of showing a teaching or suggestion to combine *Campbell* with *Seufert* '916 and rejections based thereupon should be withdrawn.

D. The transparent foil of *Seufert* '916 does not act as a reinforcing material as required by *Campbell* and as specified in the claimed invention

Seufert '916 does not disclose that the transparent plastic foil is a reinforcing material or performs a reinforcing function such as performed by the tapes shown in *Campbell*. Indeed, since the thickness of the *Seufert* '916 foil is between 40-60 μm at its thinned downed regions, such material clearly is not designed to be a reinforcing material as specified in the claimed invention or as required by *Campbell*. Further, *Seufert* '916 does not teach or suggest a method of making a reinforced paperboard container with a reinforcing material, but rather is specifically directed to the making of display type boxes having cutouts over which the transparent foil is placed to form windows in, and/or walls of, the boxes. Thus, there is no suggestion to combine or form the transparent plastic material of *Seufert* '916 with the method of *Campbell* to form a reinforced fiberboard blank.

Applicant, therefore, respectfully requests that the rejection based on *Campbell* and *Seufert* '916 be withdrawn and that claims 1-5, 7, 11 and 33-37 as now pending be allowed over the cited combination of references.

II. Dependent Claims 6, 8-10, and 12-15

Claim 6 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over *Campbell* et al. in view of *Seufert* '916 as applied to claims 1-5, 7, 11 and 33-37, and in further view of *Seufert* '206. Applicant respectfully submits that claim 6, which depends from claim 5, likewise is allowable over the cited art of record for the reasons discussed above with reference to Claims 1-5. Accordingly, it is respectfully requested that this rejection be withdrawn and that claim 6 is patentable under 35 U.S.C. § 103(a) over the cited art of record.

Claims 8-10 and 12-15 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over *Campbell* in view of *Seufert* '916 as applied to claims 1-5, 7, 11 and 33-37 and in further view of *Haddock*. As discussed above with reference with claims 1-5, 7, 11 and 33-37, it is submitted that there is no suggestion or motivation, nor has any such suggestion or motivation been shown to support the combination of the teachings of *Campbell* in view of *Seufert* '916. It is therefore submitted that claims 8-10 and 12-15 are not made obvious by and thus are patentable over the cited combination of references, and it is respectfully submitted that this rejection be withdrawn.

III. Conclusion

Claims 1-5, 7, 11, and 33-37 are not rendered obvious by *Campbell* in view of *Seufert* '916 under 35 U.S.C. § 103(a). Claim 6 is not rendered obvious by *Campbell* in view of *Seufert* '916 and in further review of *Seufert* '206 under 35 U.S.C. § 103(a). Additionally, Claims 8-10 and 12-15 are not rendered obvious by *Campbell* in view of *Seufert* '916 and in further review of *Haddock* under 35 U.S.C. § 103(a).

For the foregoing reasons, the rejections of Claims 1-15 and 33-37 by the U.S. Patent and Trademark Office are in error. Reversal of the rejections and allowance of the application is respectfully requested.

AUTHORIZATION

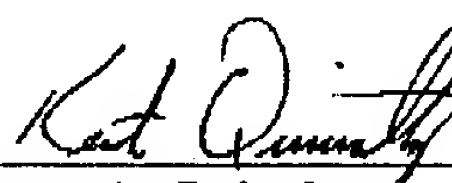
Under 37 CFR § 1.193, Applicant is entitled to file a Reply Brief within two months from the date of the Examiner's Answer mailed December 1, 2003. As explained in Applicant's Petition for Extension of Time Under 37 CFR 1.136(b) previously filed on March 1, 2004, Applicant did not receive a copy of the Examiner's Answer until February 25, 2004, after the two month period for Reply had lapsed. Applicant has filed this Reply Brief on March 16, 2004,

which is within three weeks of actual receipt of the Examiner's Answer and requests entry and consideration of this Reply Brief.

Although the Applicant does not believe any fee is due by the filing of this Reply Brief, the Commissioner is hereby authorized to charge any additional fees that may be required for the timely consideration of this Reply Brief to Deposit Account No. 09-0528.

Respectfully submitted,

3/16/04
Date



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